

REMARKS

The Non Final Office Action mailed December 19, 2007, has been received and reviewed. Claims 28-63 are pending in the subject application.. Claims 28, 39, 40, 51, 52, and 63, have been amended herein. Care has been exercised to introduce no new matter. Reconsideration of the pending application in view of the amendments and the following remarks is respectfully requested.

Summary of Examiner Interview

Applicant thanks Examiner LeRoux for the in person interview conducted on March 13, 2008. Potential claim amendments were discussed, as well as differences between the claimed invention and the cited references.

Rejections based on 35 U.S.C. § 112, 1st Paragraph

Claims 39, 51, and 63 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Claims 39, 51, and 63 have been amended herein to more clearly recite features of the claimed invention. Claims 39 now reads, in part "... wherein if there is ~~not~~ sufficient memory available on the PSD to store a user profile" Claim 51 now reads, in part "wherein if there is not sufficient memory available on the PSD to store a user profile, offering to free up storage space on the PSD by deleting files stored on the PSD." Claim 63 has been amended in a similar fashion. As such, it is respectfully submitted that claims 39, 51, and 63 comply with 35 U.S.C. § 112, first paragraph. Accordingly, withdrawal of the rejection of the claims is respectfully requested.

Rejections based on 35 U.S.C. § 102(b)

A.) Applicable Authority

“A claim is anticipated only if each and every elements as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdeggal Brothers v. Union Oil Co. of California*, 814 F.3d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1336, 2 USPQ 2d 1913, 1920 (Fed. Cir. 1989). *See also*, MPEP §2131.

B.) Anticipation rejections based on Horvitz et al. (U.S. Patent No. 6,262,730)

Claims 28, 40, and 52 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,262,730 to Horvitz et al. (hereinafter the “Horvitz reference”). As the Horvitz reference fails to describe, either expressly or inherently, each and every element as set forth in the rejected claims 28, 40, and 52 , Applicants respectfully traverse this rejection, as hereinafter set forth.

Independent claim 28, as herein amended, recites a method for creating a user profile. The method of claim 27 comprises the steps of: upon detecting a connection of a Portable Storage Device (PSD) to a computing device, scanning the PSD for an indication of an existing user profile containing data files, application settings and user environment settings, wherein the user environment settings comprise a user's desktop configuration, start menu configuration or other operating system shell configurations; and in response to detecting that no existing user profile is found on the PSD, automatically launching a user profile connection wizard that enables the user to create a user profile on the PSD.

As a threshold matter, it is noted that the Office has not addressed the feature of claim 28 of “scanning the PSD for an indication of an existing user profile.” Should the Office

choose to maintain the rejection in light of the amendments presented herein, Applicants respectfully request that support for the teaching of this feature in cited references be provided.

In support of the rejection of the feature of “upon detecting a connection of a Portable Storage Device (PSD) to a computing device,” the Office cites to the handheld device of Figures 1 and 10, along with col. 6, line 45 and new user detected step 140 of Figure 11 of the Horvitz reference. The handheld device cited by the Office is mentioned in the Horvitz reference in passing. The Horvitz reference merely states that computer system depicted in Figure 1 is illustrative and the invention of Horvitz may be practiced on with other computer system configurations, including a handheld device. *Horvitz reference*, col. 6, lines 38-45. The Horvitz reference does not teach or contemplate the step of upon detecting a connection of a Portable Storage Device (PSD) to a computing device, scanning the PSD for an indication of an existing user profile. The ‘new user detected’ step 140 of Figure 11 is directed to detecting when a user logs on to a system or application. *Id.* at col. 17, lines 60-67. The user profile access routine then searches the local user profile database for that user’s profile. *Id.*

The Horvitz reference is broadly directed to monitoring user interaction with software programs and applying probabilistic reasoning to sense that the user may need assistance in using a particular feature or to accomplish a particular task. *Id.* at abstract. The mention in the Horvitz reference of a handheld device is only in passing and serves to disclose that the teachings of the Horvitz reference could be implemented on a handheld device, in addition to a traditional person computer. Further, the new user detected step is only performed when a user logs onto to the system or application in Horvitz. *Id.* at col. 17, lines 60-67. The step is not performed upon the detecting of a connection of a Portable Storage Device (PSD) to a computing device. The Horvitz reference simply provides no mention, either explicit or

inherent, of scanning a PSD for an existing user profile upon detecting that a connection of the PSD to a computing device.

The Office cites to Figure 11 and col. 17 lines 55 through col. 18 lines 15 in support of the rejection of the additional features of claim 28 of “in response to detecting that no existing user profile is found, automatically launching a user profile configuration wizard.” Independent claim 28 has been amended herein, to more clearly recite that that the step is carried out in response to detecting that no existing user profile is found on the PSD, launching a user profile connection wizard that enables the user to create a user profile on the PSD. The portions of the Horvitz reference cited by the Office are only directed to creating a profile on the computing device being utilized by the user. The Horvitz reference does not contemplate, nor teach, the creation of a profile on a PSD that is connected to a computing device.

Additionally the newly recited features of claim 28 serve to more clearly define the user profile as containing data files, application settings and user environment settings, wherein the environment settings comprise a user's desktop configuration for instance. The user profile referred to in the Horvitz reference is only directed to storing the user's needs for assistance so that varying levels of help may be provided to a user. *Id.* at col. 18, lines 5-20. As such, the user profile of the Horvitz reference is not analogous the user profile of claim 28. The Horvitz reference makes no mention, either express or inherent of the newly added features in amended independent claim 28.

As such, it is respectfully submitted that the Horvitz reference fails to describe, either expressly or inherently, each and every element of independent claim 28, as herein amended. Accordingly, claim 28 is not anticipated by the Horvitz reference and withdrawal of

the 35 U.S.C. § 102(b) rejection is respectfully requested. Claim 28 is believed to be in condition for allowance and such favorable action is hereby respectfully requested.

Claims 40 and 52 were rejected by the Office under the same reasoning as claim 28. Claims 40 and 52 have been amended here to recite, in part “upon detecting a connection of a Portable Storage Device (PSD) to a computing device, scanning the PSD for an indication of an existing user profile containing data files, application settings and user environment settings; and in response to detecting that no existing user profile is found on the PSD, automatically launching a user profiled connection wizard.”

In support of the rejection of the feature of “upon detecting a connection of a Portable Storage Device (PSD) to a computing device,” the Office cites to the handheld device of Figures 1 and 10, along with col. 6, line 45 and new user detected step 140 of Figure 11 of the Horvitz reference. The handheld device cited by the Office is mentioned in the Horvitz reference in passing. The Horvitz reference merely states that computer system depicted in Figure 1 is intended to illustrate that the invention of Horvitz may be practiced with other computer system configurations, including a handheld device. *Horvitz reference*, col. 6, lines 38-45. The Horvitz reference does not teach or contemplate the step of upon detecting a connection of a Portable Storage Device (PSD) to a computing device, scanning the PSD for an indication of an existing user profile. The ‘new user detected’ step 140 of Figure 11 is directed to detecting when a user logs on to a system or application. *Id.* at col. 17, lines 60-67. The user profile access routine then searches the local user profile database for that user’s profile. *Id.*

As discussed above, the Horvitz reference is broadly directed to monitoring user interaction with software programs and applying probabilistic reasoning to sense that the user

may need assistance in using a particular feature or to accomplish a particular task. *Id.* at abstract. The mention in the Horvitz reference of a handheld device is only in passing and serves to disclose that the teachings of the Horvitz reference could be implemented on a handheld device, in addition to a traditional person computer. Further, the new user detected step is only performed when a user logs onto the system or application in Horvitz. *Id.* at col. 17, lines 60-67. The step is not performed upon the detecting of a connection of a Portable Storage Device (PSD) to a computing device. The Horvitz reference simply provides no mention, either explicit or inherent, of scanning a PSD for an existing user profile upon detecting that a connection of the PSD to a computing device.

The Office cites to Figure 11 and col. 17 lines 55 through col. 18 lines 15 in support of the rejection of the additional features of claims 40 and 52 of “in response to detecting that no existing user profile is found, automatically launching a user profile configuration wizard.” Independent claims 40 and 52 have been amended herein, to more clearly recite that that the step is carried out in response to detecting that no existing user profile is found on the PSD, launching a user profile connection. The portions of the Horvitz reference cited by the Office are only directed to creating a profile on the computing device being utilized by the user. The Horvitz reference does not contemplate, nor teach, the creation of a profile on a PSD that is connected to a computing device

Additionally the newly recited features of claims 40 and 52 serve to more clearly define the user profile as containing data files, application settings and user environment settings. The user profile referred to in the Horvitz reference is only directed to storing the user’s needs for assistance so that varying levels of help may be provided to a user. *Id.* at col. 18, lines 5-20. As such, the user profile of the Horvitz reference is not analogous the user profile of claims 40

and 52. The Horvitz reference makes no mention, either express or inherent of the newly added features in amended independent claims 40 and 52.

As such, it is respectfully submitted that the Horvitz reference fails to describe, either expressly or inherently, each and every element of independent claims 40 and 52, as herein amended. Accordingly, claims 40 and 52 are not anticipated by the Horvitz reference and withdrawal of the 35 U.S.C. § 102(b) rejections is respectfully requested. Claims 40 and 52 are believed to be in condition for allowance and such favorable action is hereby respectfully requested.

Rejections based on 35 U.S.C. § 103

A. Applicable Authority

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestions or motivations found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See, *Application of Bergel*, 292 F. 2d 955, 956-957

(1961). Thus, in order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP § 2143. Recently, the Supreme Court elaborated, at pages 13-14 of *KSR*, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

B. Rejections based on the Horvitz reference in view Kruglikov et al. U.S. Patent 6,505,215, hereinafter “the Kruglikov reference.”

Claims 29-38, 41-50, and 52-62 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Horvitz reference in view of the Kruglikov. As the Horvitz reference and the Kruglikov reference, either alone or in combination, fail to teach or suggest all of the claim limitations of claims 29-38, 41-50, and 52-62, Applicants respectfully traverses this rejection, as hereinafter set forth.

Claims 29-38, 41-50, and 52-62 depend, either directly or indirectly, from claims 28, 40, and 52, and are therefore patentable over the Horvitz reference for at least the reasons cited above. The Kruglikov reference fails to cure the deficiencies of the Horvitz reference with respect to its failure to teach or suggest scanning the PSD for an indication of an existing user

profile upon detecting a connection of a PSD to a computing device, and in response to detecting that no existing user profile is found, automatically launching a user profile configuration wizard. As the Horvitz reference does not teach the features of independent claims 28, 40, and 52, a *prima facie* case of obviousness has not been made for the rejection of claims 29-38, 41-50, and 52-62. Furthermore, the Kruglikov reference is not relied upon to cure the deficiencies of the Horvitz reference as applied to the independent claims above.

Moreover, claims 29-38, 41-50, and 52-62, recite further novel, non-obvious features not taught or suggested in the cited references in the context of independent claims 28, 40, and 52. Accordingly, Applicants respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejections of claims 29-38, 41-50, and 52-62 as well. Claims 29-38, 41-50, and 52-62 are believed to be in condition for allowance and such favorable action is respectfully requested.

CONCLUSION

For at least the reasons stated above, claims 28-63 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or ahale@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due with the present amendment. However if this belief is in error, the Commissioner is hereby authorized to charge any amount required, or credit any overpayment, to Deposit Account No. 19-2112, referencing attorney docket no. MFCP.139604.

Respectfully submitted,

/Adam G. Hale/

Adam G. Hale
Reg. No. 60,433

AGH/tq
SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108-2613
816-474-6550